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Brian Leslie Smalley

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WOMBLE CARLYLE SANDRIDGE & RICE, PLLC

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COLLINS, MICHAEL

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,887	<b>Applicant(s)</b> SMALLEY ET AL.	
	<b>Examiner</b> MICHAEL K. COLLINS	<b>Art Unit</b> 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,9 and 60-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 67-69,74 and 77 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,9,60-66,70-73,75 and 76 is/are rejected.
- 7) ☒ Claim(s) 1,64 and 67 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 10/01/2009 have been fully considered but they are not persuasive. The Applicants' argue, "Applicants are unclear whether the Examiner is asserting that each claim is rejected as anticipated under 102(b) (with *Hoy* providing each element) or under 103(a) (with *Hoy* lacking certain elements that the Examiner believes are obvious to add). This failure of the Examiner to present specific rejections renders the First Office Action moot and will not enable a Second Office Action to be made final." However, claims 1, 6, 9, 60-69 cite each element of the claim as provided by *Hoy et al.* Claims 2 and 4 provide evidence as to why the lacking elements are obvious to a person of ordinary skill within the art. Therefore, this argument is not convincing. Nevertheless, for the purpose of clarity, separate headings will be provided for the rejection of claims under 102(b) and 103(a) in this Office Action.

The Applicants' argue, "Claims 1 and 64 recite that 'the first portion being removable from the carton.' *Hoy* cannot anticipate at least this element since the stop 56 of *Hoy* is formed from strips 58 and 60, which are provided to restrict containers from rolling out of the carton." However, it is the removal of strips 58 and 60 which creates a first opening allowing article removal. Therefore, this argument is not convincing.

For the foregoing reasons claims 1, 2, 4, 6, 9 and 60-66 stand rejected. Newly added claims 70-77 have also been addressed with reference to *Hoy et al.* in this Office Action.

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2. Regarding claim 67 the Applicants' argue, "Further, claim 67 provides a tear line arrangement that includes a first tear line and a second tear line in the third panel spaced a predetermined distance. *Hoy* fails to disclose the claimed tear line arrangement." Applicants' arguments with respect to claim 67 have been fully considered and are persuasive. The rejection of claims 67-69 has been withdrawn.

### ***Claim Objections***

3. Claims 1, 64 and 67 are objected to because of the following informalities: Claims 1, 64 and 67 are objected to under 37 CFR 1.75(i). The claims should provide indentation for each element. Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6, 9, 60-66, 70-73, and 75-76 are rejected under 35 U.S.C. 102(b) as being anticipated by *Hoy et al.* (USP 5,878,947).

Regarding claim 1, *Hoy et al.* disclose a paperboard carton for articles arranged in an end-on-end relationship, the carton comprising:

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- six sides (20/18,14,16,12,30/32,40/42), the six sides including a first side (30/32) disposed between a second side (14) and a third side (12), the first side being perpendicular a fourth side (16), the second side (14), and the third side (12), the second side and the third side being parallel (see Figure 1),
- a two-piece dispenser (30A/32A,58,60,62) that includes a first portion (58,60,62) and a second portion (30A/32A);
- the first portion (58,60,62) defined at least partially along its perimeter by a first tear line (see Figure 5);
- the first portion (58,60,62) extending at least partially into the first side, the second side, and the third side (see Figures 4-7);
- the first portion (58,60,62) being removable from the carton along the first tear line to create a first opening for article removal (see Figure 7), the second portion (30A/32A) being adjacent the first portion (58,60,62) and being defined at least partially along its perimeter by the first tear line, a first provision (12A), and a second provision (14A);
- the first provision (12A) having a first end proximate the first portion and a second end distal the first portion (see Figures 5-6), the second end of the first provision (12A) being intersected by a first intersection line that prevents the first provision from extending beyond its intended length (see Figures 1-2 and 4-7);
- the second provision (14A) having a first end proximate the first portion and a second end distal the first portion (see Figure 4), the second end of the second provision being intersected by a second intersection line that prevents the

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second provision from extending beyond its intended length (see Figures 2, 4, and 7);

- the second portion (30A/32A) being separable along the first provision (12A) and the second provision (14A) to create a second opening in the carton (see Figures 2, 3, and 7);
- wherein the second opening and the first opening together define an enlarged opening, the enlarged opening enabling easier article removal from the carton than the first opening alone (see Figures 2, 3, and 7).

Regarding claim 6, Hoy et al. disclose the carton of claim 1 wherein the first provision and the second provision are parallel (see Figure 7).

Regarding claim 9, Hoy et al. disclose the carton of claim 1 wherein the six sides are arranged substantially rectangular (see Figures 1-4).

Regarding claim 60, Hoy et al. disclose the carton of claim 1 wherein the first tear line defines a perimeter section of the second portion (30A/32A) in the first side (30/32).

Regarding claim 61, Hoy et al. disclose the package of claim 64 wherein the first tear line defines a perimeter section of the second portion (30A/32A) in the first side (30/32).

Regarding claim 62, Hoy et al. disclose the carton of claim 1, wherein the first and second provisions are cuts (see Figures 4-7).

Regarding claim 63, Hoy et al. disclose the carton of claim 1, wherein the first and second intersection lines are cuts (see Figures 2, 4, and 7).

Regarding claim 64, Hoy et al. disclose a package comprising:

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- a plurality of articles (52);
- a paperboard carton (10) for enclosing the plurality of articles in rows, the carton comprising:
  - six sides (20/18,14,16,12,30/32,40/42), the six sides including a first side (30/32) disposed between a second side (14) and a third side (12), the first side (30/32) being perpendicular a fourth side (16), the second side (14), and the third side (12), the second side and the third side being parallel (see Figures 1-4),
  - a two-piece dispenser (30A/32A,58,60,62) that includes a first portion (58,60,62) and a second portion (30A/32A);
  - the first portion (58,60,62) defined at least partially along its perimeter by a first tear line (see Figures 1 and 4-6);
  - the first portion (58,60,62) extending at least partially into the first side, the second side, and the third side (see Figures 1 and 4-6);
  - the first portion (58,60,62) being removable from the carton along the first tear line to create a first opening for article removal (see Figures 2, 3, and 7), the second portion (30A/32A) being adjacent the first portion (58,60,62) and being defined at least partially along its perimeter by the first tear line (see Figures 1-2 and 5-7), a first provision (12A), and a second provision (14A);
  - the first provision (12A) having a first end proximate the first portion and a second end distal the first portion (see Figures 1 and 4-6), the second end

of the first provision being intersected by a first intersection line that prevents the first provision from extending beyond its intended length (see Figures 2, 4, and 7);

- the second provision (14A) having a first end proximate the first portion and a second end distal the first portion (see Figure 4), the second end of the second provision being intersected by a second intersection line that prevents the second provision from extending beyond its intended length (see Figures 2, 4 and 7);
- the second portion (30A/32A) being separable along the first provision and the second provision to create a second opening in the carton (see Figures 2-3 and 7);
- wherein the second opening and the first opening together define an enlarged opening, the enlarged opening enabling easier article removal from the carton than the first opening (see Figures 2-3 and 7).

Regarding claim 65, Hoy et al. disclose the package of claim 63, wherein the first and second provisions are cuts (see Figures 1 and 4).

Regarding claim 66, Hoy et al. disclose the package of claim 63, wherein the first and second intersection lines are cuts (see Figures 1 and 4).

Regarding claim 70, Hoy et al. disclose the carton of claim 1 wherein the second portion (30A/32A) is hingeable at the first intersection line and the second intersection line (see Figures 2 and 7).

Regarding claim 71, Hoy et al. disclose the package of claim 64 wherein the



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second portion is hingeable at the first intersection line and the second intersection line (see Figures 2 and 7).

Regarding claim 72, Hoy et al. disclose the carton of claim 1 wherein the first side and the fourth side intersect at a fold line and wherein the first intersection line and the second intersection line are spaced from the fold line (see Figure 4).

Regarding claim 73, Hoy et al. disclose the package of claim 64 the first side and the fourth side intersect at a fold line and wherein the first intersection line and the second intersection line are spaced from the fold line (see Figure 4).

Regarding claim 75, Hoy et al. disclose the carton of claim 1 wherein the first portion is removable from the second portion (see Figures 5-7).

Regarding claim 76, Hoy et al. disclose the package of claim 64 wherein the first portion is removable from the second portion (see Figures 5-7).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoy et al. (USP 5,878,947) as applied to claims 1, 6, 9, 60-66, 70-73, and 75-76 above.

Regarding claim 2, Hoy et al. disclose the carton of claim 1. However, they do not disclose a carton wherein a divider pad is secured to the inside of the carton. Yet, adding this feature would have been obvious because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Regarding claim 4, Hoy et al. disclose the carton of claim 2. However, they do not disclose a carton wherein the divider pad has a fold down gluing panel. Yet, adding this feature would have been obvious because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

### ***Allowable Subject Matter***

9. Claims 67-69, 74, and 77 are allowed.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL K. COLLINS whose telephone number is (571)272-8970. The examiner can normally be reached on 8:30 am - 5:00 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.K.C.  
1/14/2010

/Gene Crawford/  
Supervisory Patent Examiner, Art  
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